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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/816,122	03/11/97	BUSH	A 0609.4350000

HM11/0211
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EXAMINER
SPIEGEL, C

ART UNIT	PAPER NUMBER
1645	87

DATE MAILED: 02/11/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-39 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1817

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 32-33 and 15-20 to the extent claims 15-20 require Cu(II) ions, drawn to complexation methods for identifying agents capable of altering the redox production of Cu(I) ions by amyloid β protein precursor and kits therefore, classified in class 436, subclass 80.
 - II. Claims 8-14, 34-35 and 15-20 to the extent claims 15-20 require Fe(III) ions, drawn to complexation methods for identifying agents capable of altering the redox production of Fe(II) ions by amyloid β protein precursor and kits therefore, classified in class 436, subclass 84.
 - III. Claims 21-23, drawn to methods of identifying agents capable of decreasing $O_2^{\cdot -}$ production by amyloid β protein precursor, classified in class 436, subclasses 127 and 136.
 - IV. Claims 24-25, drawn to methods of identifying agents capable of decreasing $O_2^{\cdot -}$ production by amyloid β protein precursor without interfering with the SOD-like activity of the amyloid β protein precursor, classified in class 435, subclass 25 and class 436, subclasses 127 and 136.
 - V. Claims 26-31, drawn to bioassays for identifying agents capable of reducing the neurotoxicity of amyloid β protein precursor, classified in class 436, subclass 63 and class 435, subclass 26.
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Art Unit: 1817

VI. Claims 38-39, drawn to methods for identifying agents capable of inhibiting crosslinking of amyloid β protein precursor, classified in class 436, subclass 63.

The inventions are distinct, each from the other because:

Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each have different modes of operation; require different analytical reactions, reagents and parameters; and produce different measurable products, i.e. have different effects. Different issues of enablement, correlation of intended functional use (i.e. identification of a therapeutic agent) to therapy, etc. are raised by each group. Thus, art against one group cannot be used to render obvious any other group, e.g. copper and iron belong to different groups in the periodic chart; bioassays and neurotoxicity assays are totally different from inorganic chelate complexation assays, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter; and because the search required for any one of inventions I-VI is not substantially coextensive with the search required for the remaining inventions, restriction for examination purposes as indicated is proper.

Art Unit: 1817

A telephone call was made to Raz E. Fleshner, Reg. No. 34,331 on February 3 and 5, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

CHANGE IN ART UNIT

Effective February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1645.

CLOSING

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol A. Spiegel whose telephone number is (703) 308-3986.

Serial Number: 08/816,122

Page 5

Art Unit: 1817

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Paula K. Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Carol A. Spiegel
February 6, 1998

Carol A. Spiegel
CAROL A. SPIEGEL
PRIMARY EXAMINER
GROUP 1800